

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 17, 21, 25, and 26 will have been amended and claims 18 and 22 will have been canceled. The substantive limitations of claims 18 and 22 will have been incorporated into claims 17 and 21. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 17-18, 21-22, and 25-35 under 35 U.S.C. § 103(a) as being unpatentable over LO et al. (U.S. Patent No. 5,911,044). The Examiner has also rejected claims 19-20 and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over LO et al. in view of IDEHARA (U.S. Patent Publication 2002/0038372). Applicant traverses the above rejections.

As noted above, Applicant has amended claims 17, 21, 25 and 26 and has canceled claims 18 and 22. Applicant respectfully traverses the above rejection based on the pending claims 17, 19-21 and 23-35 and will discuss the outstanding rejection with respect to these claims, pending in the present application, as will be set forth hereinbelow. The amendments to the claims merely clarify the subject matter recited therein, but do not narrow the scope of the claims.

Applicant's claims 17, 19-20, 27, 28 and 33 generally relate to a scanner apparatus which scans image data and includes an interface configured to be connected to a terminal apparatus via a network. The scanner apparatus includes a

controller which includes a search packet receiver configured to receive, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus to be connected to the terminal apparatus. The search packet includes identification information, the identification information identifying the terminal apparatus. The controller has a determiner configured to determine whether the identification information of the search packet matches identification information of the scanner apparatus. The controller also includes a response transmitter configured to transmit, to the terminal apparatus, a response to the search packet when it is determined that the identification information of the search packet matches the identification information of the scanner apparatus. The controller additionally includes a receiver configured to receive, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus. The controller also includes a transmitter configured to transmit to the terminal apparatus the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Claims 21, 23-24, 29-30 and 34 recite generally related terminal apparatuses. Claim 25, 31-32 and 35 recite generally related systems. Claim 26 recites a generally related method.

In direct contrast, LO et al. relate to a network image scanning system for performing scanning operations using a scanner connected to a server computer and transmitting acquired images from the scanner server to a client computer.

However, LO et al. do not disclose at least a scanner including a search packet receiver that receives, from the terminal apparatus, a search packet, the search packet

being utilized to search for a scanner apparatus connectable to the terminal apparatus, the search packet including identification information, the identification information identifying the terminal apparatus. In setting forth the rejection, the Examiner cites col. 12, lines 50-58 and col. 19, lines 8-28. However, col. 12, lines 50-58 explains the set parameters packet header 320 for setting the scanning parameters from the client computer to the scanner server, as shown in Fig. 7G. The scanning parameter is utilized for scanning a document, but is not utilized for searching for an available network scanner.

On the other hand, col. 19, lines 8-28 explains, *inter alia*, that step 740 of Fig. 14A determines the network scanners such as the scanner 144 which are available for the scan-to-file operation. The cited portion does not show how to determine an available network scanner. According to the cited portion, step 740 can be carried out in the same way as step 456 of Fig.8A. Step 456 of Fig.8A determines whether or not there are network scanners available. This cited portion also does not show how to determine an available network scanner, as recited herein. Thus, Applicant submits that "LO et al. do not disclose at least a search packet receiver that receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, the search packet including identification information, the identification information identifying the terminal apparatus".

In this regard, Applicant wishes to make of record a telephone interview conducted between Applicant's undersigned representative and Examiner Patel in charge of the present application. During the above-noted interview, Applicant's

representative pointed out the shortcomings of the LO et al. reference cited and relied upon by the Examiner.

During the interview, the Examiner directed Applicant's attention to the paragraph at col. 14, starting at line 17. The Examiner noted that packets are disclosed therein and that they are periodically transmitted. The Examiner asserted that this disclosure reads on Applicant's claims. Applicant respectfully submits that the Examiner's position is incorrect. In particular, Applicant notes that according to the features of Applicant's invention as recited, e.g., in claim 17, the scanner apparatus includes a controller which is configured to receive search packets from the terminal apparatus. In direct contrast, according to the teachings of the above-cited paragraph of LO et al., the client computer is configured to monitor packets which are transmitted by a server which is substantially the opposite of the claim recitations.

Moreover, Applicant's claim 17 recites that the search packets include "identification information, the identification information identifying the terminal apparatus". It is respectfully submitted that there is no disclosure that the packets of LO et al. contain information identifying the terminal apparatus. In this regard, Applicant respectfully directs the Examiner's attention to col. 9, lines 46-47, wherein LO et al. explicitly discloses that source and destination addresses are not needed in the packet header of Fig. 6. For this additional reason, it is respectfully submitted that LO et al. contains a disclosure that is inadequate and insufficient to render unpatentable any of the claims in the present application.

Applicant further notes that according to the teachings of LO et al. as expressed in the above-noted paragraph, the SAP protocol also allows an inquiry request relating

to available network services to be transmitted by a client which is responded to by a server. However, even this embodiment of LO et al. does not comply with the recitations of Applicant's claims. In this regard, where the inquiry request is responded to by the server, the server would, Applicant submits, identify itself rather than as is required by Applicant's claim, receive a search packet which includes identification information identifying the terminal apparatus. Thus, neither of the two alternatives disclosed by LO et al. are adequate or sufficient to teach the recitations of Applicant's invention.

Moreover, at the paragraph bridging cols. 14 and 15 of LO et al., LO et al. discloses that a user can select an available network scanner from a list by using a graphical user interface. This is further evidence that a "search packet receiver" as recited, e.g., in claim 17, is not taught, disclosed or rendered obvious by LO et al.

Applicant wishes to respectfully thank the Examiner for the kindness and courtesy exhibited during the above-noted interview both in the scheduling and in the conducting of the same. However, for reasons as least set forth below, Applicant submits that the Examiner's interpretation of the LO et al. reference is inappropriate.

LO et al. also do not disclose a determiner that determines whether the identification information of the search packet matches identification information of the scanner apparatus. As discussed above, LO et al. merely disclose the set parameters packet header 320 for setting the scanning parameters from the client computer to the scanner server and determines which of the network scanners, such as the scanner 144, are available for the scan-to-file operation without showing how to determine the available network scanner, in the manner recited. Thus, Applicant submits that LO et

al. do not disclose a determiner that determines whether the identification information of the search packet matches identification information of the scanner apparatus.

Further, LO et al. do not disclose a response transmitter that transmits, to the terminal apparatus, a response to the search packet when it is determined that the identification information of the search packet matches the identification information of the scanner apparatus. In setting forth the rejection, the Examiner cited col.12, lines 59-62. However, this cited portion merely explains that the scanner server transmits the set parameters acknowledge packet header 340 to the client computer. However, the set parameters acknowledge packet header 340 is a response to the set parameters packet header 320. The set parameters packet header 320 is utilized for setting the scanning parameters, but is not utilized for searching for an available network scanner.

Further, LO et al. do not disclose a determiner that determines whether the identification information of the search packet matches identification information of the scanner apparatus, as discussed above. Thus, Applicant submits that LO et al. do not disclose a response transmitter that transmits, to the terminal apparatus, a response to the search packet "when it is determined that the identification information of the search packet matches the identification information of the scanner apparatus".

The present invention recites a search packet receiver that receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, the search packet including identification information, the identification information identifying the terminal apparatus. The present invention also recites a determiner that determines whether

the identification information of the search packet matches identification information of the scanner apparatus. Further, the present invention recites a response transmitter that transmits, to the terminal apparatus, a response to the search packet when it is determined that the identification information of the search packet matches the identification information of the scanner apparatus. Each of these features, in the claims combinations, is not disclosed or taught by LO et al.

Thus, the pending claims are clearly patentable over LO et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 17, 19-21, 23-35 are not anticipated by LO et al. cited by the Examiner. An action to such effect is respectfully requested.

Regarding the rejection of claims 19-20 and 23-24 under U.S.C. §103(a) as being unpatentable over LO et al. in view of IDEHARA et al., Applicant notes that the IDEHARA et al. reference is not available as a reference against the pending claims. The IDEHARA et al. reference issued on March 28, 2002 and was filed in the U.S. Patent and Trademark Office on September 25, 2001. Thus, its availability as reference against any of the claims in the present application is only under 35 U.S.C. § 102(e).

In this regard, Applicant notes that the present application is based on and enjoys the effective filing date of JP 2001-026646 which was filed on February 2, 2001, which is before the 35 U.S.C. § 102(e) date of the IDEAHARA et al. reference relied on by the Examiner. Thus, Applicant submits that the IDEHARA et al. reference is an inappropriate basis for the rejection of any of the claims in the present application. 35 U.S.C. § 102(e) specifies "the invention was described in --- a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent". Applicant notes that under 102(e) only the U.S. filing date of the reference can be relied upon. Thus, the IDEHARA et al. reference constitutes an inappropriate basis for the rejection of any of the claims in the present application since IDEHARA et al. was filed after the invention of the pending claims, not "before the invention by the applicant for patent", as required for IDEHARA et al. to come within the terms of 35 U.S.C. § 102(e).

Therefore, it is respectfully submitted that the features recited in Applicant's claims 19-20 and 23-24 are not rendered unpatentable by the disclosure of IDEHARA et al. cited by the Examiner, since IDEHARA et al. is an inappropriate reference. Thus, since the IDEHARA et al. reference is an inappropriate basis for the rejection of any of the claims in the present application, no proper combination of LO et al. and IDEHARA et al. can be adequate to render Applicant's claims unpatentable.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections, and requests an indication of the allowability of all the claims pending in the present application, in due course.



SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has made of record a telephone interview conducted with the Examiner of the present application. Applicant has amended the rejected claims and submitted the same for reconsideration by the Examiner.

With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the claims with the disclosures of the applied references. Applicant has also pointed out that the secondary reference relied upon by the Examiner has an inappropriate date and is, thus, not available as a reference against any of the claims in the present application. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

P21952.A10

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Yutaka IYOKI



Bruce H. Bernstein  
Reg. No. 29,027

William Pieprz  
Reg. No. 33,630

September 25, 2006  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191  
{P21952 00061941.DOC}